

REMARKS

The Examiner has rejected Claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2003/0100932 to Ciaff (“Ciaff”) in view of U.S. Patent No. 5,775,331 to Raymond et al. (“Raymond”). The Examiner has also rejected Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ciaff in view of Raymond, and further in view of U.S. Patent No. 4,817,628 to Zealear et al. (“Zealear”). IClaims 1-3 stand currently amended. Claims 1-3 are currently pending. The following remarks are considered by applicant to overcome each of the Examiner’s outstanding rejections to current Claims 1-3. An early Notice of Allowance is therefore requested.

I. SUMMARY OF RELEVANT LAW

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art, and (4) whatever objective evidence may be present. Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. The Examiner carries the burden under 35 U.S.C. § 103 to establish a prima facie case of obviousness and must show that the references relied on teach or suggest all of the limitations of the claims.

II. REJECTION OF CLAIMS 1 AND 2 UNDER 35 U.S.C. § 103(A) BASED ON CIAFF IN VIEW OF RAYMOND

On page 2 of the current Office Action, the Examiner rejects Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ciaff in view of Raymond. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Amended Claim 1 states, in part:

“placing a probe in an area of **body tissue of a brain** of a body of a person being treated;

“treating the area of body tissue, wherein the treatment comprises the probe selecting **and removing** any pathologically changed tissue parts...” (emphasis added).

Accordingly, amended Claim 1 requires that the probe be placed in an area of body tissue of a brain. The Examiner admits that Ciaff discloses a device for the diagnosis and therapy of neuromuscular disorders. To that effect, it is muscle tissue which is stimulated directly in Ciaff and the reaction of the muscle tissue is used for the diagnosis and/or therapy of the type of neuromuscular disorder. However, as clearly stated above, Claim 1 requires that brain tissue is stimulated by the probe. As such, Ciaff fails to disclose that the probe is placed in an area of body tissue of a brain, as stated in Claim 1.

In addition, as stated above, Claim 1 requires that the treatment includes removing any pathologically changed tissue parts. Examiner asserts that paragraph [0013] of Ciaff discloses this language of Claim 1. However, paragraph [0013] merely states that the device of the invention offers the doctor the possibility of a detailed analysis of the anomalous muscle groups and distinguishing between different forms of neuromuscular anomalies. Accordingly, neither paragraph [0013] nor in any other portion of Ciaff discloses or renders obvious the selection and removal of pathologically altered tissue parts.

Claim 1 also states, in part:

“wherein, if the tissue stimulation **does not identify a pathologically changed tissue part**, the probe is **repositioned** and a new area of body tissue is stimulated.” (emphasis added).

Examiner admits that Ciaff fails to teach or suggest the above claim language. Rather, Examiner points to Raymond (Col. 5, Ln. 8 – Col. 6, Ln. 60) as disclosing the above language of Claim 1.

However, the portion of Raymond to which Examiner cites relates to stimulation using an array of stimulating electrodes. Raymond, Col. 5, Lns. 22-29. These electrodes of the array may be arranged in a multi-dimensional configuration for activation in successive triplets. Raymond, Col. 5, Lns. 44-47. As such, Raymond fails to disclose that any electrode is actually repositioned in order to stimulate a new area of body tissue. Rather, Raymond teaches that a different set of electrodes are activated to stimulate different areas of the nerve. Therefore, Raymond fails to disclose a single probe which is repositioned to stimulate a new area of body tissue, according to Claim 1 above.

In addition, the above language of Claim 1 specifically states that the probe is repositioned when the tissue stimulation does not identify a pathologically changed tissue part. However, Raymond only generically discloses is that the site of stimulation is automatically modified “based on the evaluation of the response” (Raymond, Col. 6, Lns. 23-28), and that the site of stimulation is modified in accordance with a site selecting algorithm “which is based on information provided by a response detecting means and a stimulation input means” (Raymond, Col. 6, Lns. 30-33). In keeping with this generic disclosure, Raymond further discloses that the site of subsequent stimulation is automatically modified “based on an evaluation of the tumescence response.” Raymond, Col. 6, Lns. 39-41. Such a generic disclosure by Raymond fails to disclose the specific situation of the probe being repositioned when the tissue stimulation does not identify a pathologically changed tissue part, as stated in Claim 1.

Accordingly, Applicants respectfully assert that Examiner has failed to establish a prima facie case of obviousness of independent Claim 1, and corresponding Claim 2 because it is dependant from independent Claim 1. Therefore, Applicant respectfully requests that Examiner

withdraw the rejection of Claims 1 and 2 under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent Application Pub. No. 2003/0100932 to Ciaff in view of U.S. Patent No. 5,775,331 to Raymond et al.

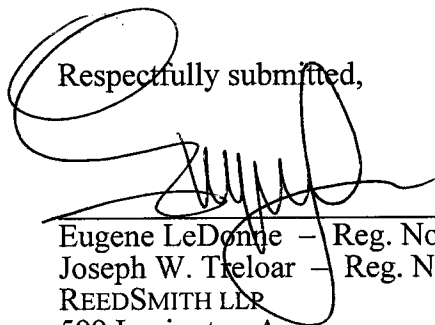
III. REJECTION OF CLAIM 3 UNDER 35 U.S.C. § 103(A) BASED ON CIAFF IN VIEW OF RAYMOND AND ZEALEAR

On page 3 of the current Office Action, the Examiner rejects Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ciaff in view of Raymond and Zealear. This rejection is respectfully traversed and believed overcome in view of the following discussion.

Claim 3 depends from independent Claim 1. As Claim 1 is allowable, so must be Claim 3. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2003/0100932 to Ciaff in view of U.S. Patent No. 5,775,331 to Raymond et al., and further in view of U.S. Patent No. 4,817,628 to Zealear et al.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Eugene LeDonne', is written over a horizontal line. The signature is stylized with a large loop at the beginning and a long horizontal stroke at the end.

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